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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,566	11/19/2003	Lawrence J. O'Connor	082018-0306944	5061
909	7590	02/24/2005	EXAMINER	
PILLSBURY WINTHROP, LLP			CHAN, SING P	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1734	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/715,566	Applicant(s) O'CONNOR, LAWRENCE J.	
	Examiner Sing P Chan	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/28/04 &amp; 11/19/03</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 10, 11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al (WO 90/10112) in view of Friedlander et al (U.S. 4,695,493) and Kalwara et al (U.S. 6,426,129).

Regarding claims 1-3, 5, and 11, O'Connor et al discloses a method of applying carpet strips to decking planks. The method includes providing a carpet strips, applying adhesive to the underside of the strips and decking planks, and adhering the strips to the planks. (Page 7, line 7 to Page 8, line 4, Page 9, lines 10 to 14, and Page 14, lines 13-17) O'Connor et al is silent as to the adhesive is a moldable adhesive or hot melt adhesive integral with the carpet, a release sheet with a separable positioning guide strip extending the length of the strip applied to the adhesive, progressively removing a length of the positioning guide strip to take a portion of the carpet in place, and removing the remaining release sheet to adhere the entire width of the carpet.

However, providing a moldable adhesive or hot melt adhesive integral with the carpet, a release sheet is well known and conventional as shown for example by Friedlander et al. Friedlander et al discloses a method of forming peel-and-stick carpet. The method

includes applying a coating of hot melt adhesive to the backing on the carpet and applying a release sheet to cover the adhesive. (Col 4, lines 4-14)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply adhesive to the underside and integral with the carpet and a release sheet to cover the adhesive as disclosed by Friedlander et al in the method of O'Connor et al to provide a pre-cut carpet to allow for rapid installation to the a surface. (Col 1, lines 33-37) O'Connor et al as modified by Friedlander et al is silent as to the release sheet includes a separable positioning guide strip extending the length of the strip applied to the adhesive, progressively removing a length of the positioning guide strip to take a portion of the carpet in place, and removing the remaining release sheet to adhere the entire width of the carpet. However, provide a release sheet with a separable positioning guide strip extending the length of the strip applied to the adhesive, progressively removing a length of the positioning guide strip to take a portion of the carpet in place, and removing the remaining release sheet to adhere the entire width of the carpet is well known and conventional as shown for example by Kalwara et al. Kalwara et al discloses a method of attaching an adhesive rubber article. The method include provide a rubber article with adhesive on the back with a release liner protecting the adhesive. The release liner also includes scored, perforated, or split and mark, i.e. indicia, in the longitudinal direction to allow a user to remove one portion of the release liner at a time, i.e. progressively, and used as a guide for aligning the article on the substrate. (Col 5, lines 13-65)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a separable positioning guide strip extending the length of the strip applied to the adhesive, progressively removing a length of the positioning guide strip to take a portion of the carpet in place, and removing the remaining release sheet to adhere the entire width of the carpet as disclosed by Kalwara et al in the method of O'Connor et al as modified by Friedlander et al to provide an alignment means for properly aligning and installing the material onto a substrate. (Col 3, lines 21-34)

Regarding claim 4, O'Connor et al discloses covering the exposed end of the plank with a portion of the floor covering turned down over the end of the plank. (Page 14, lines 18-24)

Regarding claims 6-8, O'Connor et al as modified above is silent as to the adhesive thickness is above 5 mils to 17 mils or in a volume of at least 185 grams per square meter or about 355-465 grams per square meter. However, providing an adhesive for a carpet with thickness above 5 mils to 17 mils or in a volume of at least 185 grams per square meter or about 355-465 grams per square meter is well known and conventional as shown for example by Friedlander et al. Friedlander et al discloses the hot melt adhesive is applied to the carpet material in the thickness of between 1 to 20 mils, which inherently requires a volume of at least 185 grams per square meter or about 355-465 grams per square meter. (Col 3, lines 28-32)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide adhesive with a thickness is above 5 mils to 17 mils or in

a volume of at least 185 grams per square meter or about 355-465 grams per square meter as disclosed by Friedlander et al in the method of O'Connor et al as modified by the combination of references to provide a carpet to allow for rapid installation. (Col 1, lines 32-36)

Regarding claim 10, O'Connor et al discloses turned down the floor covering material to cover the exposed end of the plank, which is considered to meet the requirement of flexing the material to conform to the shape of the board. (Page 14, lines 18-20)

Regarding claim 14, O'Connor et al is silent as to release sheet is provide with free edges that extend beyond the sides of the material and removing includes grasping the free edges. However, release sheet is provided with free edges that extend beyond the sides of the material and removing includes grasping the free edges is well known and conventional as shown for example by Friedlander et al. Friedlander et al discloses the release sheets (20) include free edges (26 and 24) that extend beyond the sides of the material and would allow removal by grasping the free edges. (Figures 1 and 2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide release sheet with free edges that extend beyond the sides of the material, which allow for removal by grasping the free edges as disclosed by Friedlander et al in the method of O'Connor et al as modified by the combination of references provide a carpet to allow for rapid installation. (Col 1, lines 32-36)

Regarding claim 15, O'Connor et al discloses the carpet material is cut into strips of a width equal to the planks, which are 4-8 inches wide. (Page 9, lines 10-12)

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al (WO 90/10112) in view of Friedlander et al (U.S. 4,695,493) and Kalwara et al (U.S. 6,426,129) as applied to claim 1 above, and further in view of Chase (U.S. 3,893,252).

O'Connor et al as modified above is silent as to the positioning strip is located in a central region and tacking the portion of the covering material in place adheres the central region and allows side regions of the elongated strip to move relative to the board. However, providing positioning strip in the central region and tacking the portion of the covering material in place adheres the central region and allows side regions of the elongated strip to move relative to the board is well known and conventional as shown for example by Chase. Chase discloses a method for mounting photos. The method includes providing a mounting board with adhesive on both surfaces and sectioned release sheets with a strip at the central portion, removing the strip, depressing the central portion of the mount onto the substrate to tacking the central portion, which allow for adjustment and repositioning, removing the remaining release sheets section and bonding the mount onto the substrate. (Col 6, lines 34-68)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a positioning strip located in a central region and tacking the portion of the covering material in place adheres the central region and allows side regions of the elongated strip to move relative to the board as disclosed by Chase in the method of O'Connor et al as modified by the combination of references to provide allow

smooth mount of the material in an accurate location on the substrate. (Col 2, lines 9-12)

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al (WO 90/10112) in view of Friedlander et al (U.S. 4,695,493) and Kalwara et al (U.S. 6,426,129) as applied to claim 11 above, and further in view of Ward et al (U.S. 4,849,267).

O'Connor et al as modified above is silent as to providing indicia indicating direction of pile of the fibrous layer. However, providing indicia indicating direction of pile of the fibrous layer is well known and conventional as shown for example by Ward et al. Ward et al discloses a method of installing a foam back carpet with release sheet. The method includes providing indicia or arrows printed to correspond to a predetermined direction of the pile yarn in the carpet. (Col 5, lines 13-22)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide indicia indicating direction of pile of the fibrous layer as disclosed by Ward et al in the method of O'Connor et al as modified by combination of references to allow the material to be readily be oriented in a common direction. (Col 5, lines 16-22)

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al (WO 90/10112) in view of Friedlander et al (U.S. 4,695,493) and Kalwara et al (U.S. 6,426,129) as applied to claim 11 above, and further in view of Ang et al (U.S. 6,517,922).



O'Connor et al as modified above is silent as to the indicia providing measuring marks. However, providing measuring marks on the release sheet on the elongated material is well known and conventional as shown for example by Ang et al. Ang et al discloses a method for finishing cut edges of floor covering. The method includes providing double sided tape and/or release sheet with visual indicia to assist in correct positioning and determining desired length of material to cut, which required measuring marks. (Col 5, lines 38-42)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide measuring marks on the release sheet as disclosed by Ang et al in the method of O'Connor et al as modified by the combination of references to allow the correct positioning and cutting of the desired length of material. (Col 5, lines 38-42)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Friday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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